

Application No.: 10/792,177
Inventor: HERNDON, Troy M.
Reply to Office Action of February 12, 2007
Docket No.: STL 3352

REMARKS/ARGUMENTS

Claim Amendments

Applicant has amended independent claim 1 to delete the phrase "one or" and to include the limitations of claim 21.

Applicant has canceled claims 2 and 21.

Applicant has amended claims 3, 8, 9 and 21 in view of the amendment to claim 1 and the cancellation of claims 2 and 21.

Applicant has presented new independent claim 23, which includes the limitations of claim 1 and 22, and new independent claim 30, which includes the limitations of claims 1 and 4.

Applicant also presents new dependent claims 24-29 and 31-34, all of which mirror the existing dependent claims, but are dependent from claim 23 or claim 30. No new matter is presented or new issues raised by the new claims.

Applicant hereby reserves the right to re-present the deleted/canceled subject matter of the instant amendments.

Entry and consideration of the instant claim amendments after final is respectfully requested as the instant claim amendments place the application in condition for allowance and/or in better form for Appeal and/or further limit issues which may be raised on appeal.

Applicants respectfully submit that the instant amendments were not previously submitted as the issues addressed by the amendments were only raised for the first time in the Final action. Accordingly, Applicants could not have made the requisite claim amendments obviating the issues at an earlier stage in the proceedings. Additionally, the instant claim amendments merely obviate the issues newly raised by the Examiner and do not change the scope of the claims or add new matter which would necessitate further substantial examination and/or search by the Examiner.

In view thereof, entry is respectfully requested.

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Remarks Regarding 35 USC § 112, First Paragraph

Claims 1-4, 6-9, 21 and 22 stand rejected, under 35 USC § 112, first paragraph, as allegedly failing to comply with the written description requirement. Applicant respectfully traverses this rejection. Solely to expedite prosecution, Applicant has amended claim 1 to remove configurations that have only one sub-journal bearing thereby rendering the rejection moot.

Remarks Regarding 35 USC § 112, Second Paragraph

Claims 3 and 7 stand rejected, under 35 USC § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. Applicant respectfully traverses this rejection.

With regard to claim 3, the Examiner indicated that claim 3 was not supported by claim 1. That is, it was unclear, for example, if there were four sub-journals, how the length of each sub-journal could be one-third the total length of the journal. Applicant directs the Examiner to paragraph [0020] of the original specification, which recites, "the groove patterns may overlap one another as long as they are substantially separate, i.e., as long as the apex(es) of each groove pattern is/are longitudinally spaced apart." Accordingly, the rejection should be withdrawn.

The Examiner also indicated that claims 3 and 4 recite that the second journal configuration has a length equal to substantially one-third of the total journal length, but that such configuration was not apparent from FIG. 2. That is, the length of each sub-journal in FIG. 2 appeared to be substantially less than one-third of the total journal length. Applicant respectfully submits that FIG. 2 is drawn for purposes of illustrating the claimed invention and should not be considered by the Examiner to be to scale. Along these lines, certain pertinent features may be exaggerated whereas relatively unimportant features may be minimized for the sake of clarity. Accordingly, the rejection should be withdrawn.

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Remarks Regarding 35 USC § 102(b)

Claims 1-4, 8, 21 and 22 stand rejected, under 35 USC § 102(b), as allegedly anticipated by Hijiya (US 4820950). Applicant respectfully traverses this rejection.

Solely to expedite prosecution, Applicant has amended claim 1 thereby rendering the rejection moot. Notwithstanding, Applicant respectfully traverses the rejection inasmuch it may apply to the claims as amended.

A printed publication anticipates a claim under §102(b) only if “each and every [claim] limitation is found either expressly or inherently in a single prior art reference.” *Celeritas Techs. Ltd. v. Rockwell Int’l Corp.*, 150 F.3d 1354, 1361 (Fed. Cir. 1998). In other words, a printed publication must include all the “limitations,” i.e., defining features of the claim, as those limitations are arranged in the claim. *See, e.g., Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Merely identifying within the prior art all of the various parts of the claimed subject matter is not anticipation. Instead, “[t]here must be *no difference* between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.” *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991) (emphasis added).

In the instant case, contrary to the Examiner’s assertion, Applicant respectfully submits that Hijiya does not disclose each and every element of amended claim 1, as arranged, to maintain a rejection under 35 USC §102(b). More specifically, Applicant respectfully submits Hijiya does not disclose a method including the steps of 1.) determining a first *stability ratio* for a first journal bearing configuration having at least two sub-journal bearings, 2.) the step of determining a second *stability ratio* for a second journal bearing configuration having at least three sub-journal bearings, wherein each of the at least three sub-journal bearings provide radial stiffness, and 3.) implementing the second journal bearing configuration where the second stability ratio is improved relative to the first stability ratio. Indeed, the “suitable” characteristics cited by the Examiner as being described by Hijiya relate to maintaining gas pressure in pocket 16, which is formed between a thrust bottom face 4 and a thrust end face 9 (See FIGS. 8-9, Col. 1, lines 44-45) and do not relate to determining first and second stability ratios as recited in

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amended claim 1. In fact, Hijiya focuses on gas pressure maintenance to avoid deterioration and frictional loss of gas (See Col. 2 lines 45-46) and does not disclose or suggest first and second stability ratios. Further, Hijiya does not disclose or suggest the step of implementing two different journal bearing configurations and selecting a superior configuration based on stability ratios. Accordingly, Hijiya does not disclose each and every element of amended claim 1.

Regarding claim 3, the Examiner further asserts "As best understood, Hijiya et al. teach the respective length ratios claimed." Applicant respectfully submits that the Examiner's assertion is mere speculation and that no such ratios are explicit or implicitly apparent from the Figures or disclosed by Hijiya. Similarly, without any explicit or implicit support in the reference, the Examiner asserts that, "[i]n figure 3 Hijiya et al. teach a different (third) journal bearing configuration, the performance characteristics which are clearly determined. Both performance characteristics clearly comprise first and second stability ratios." (emphasis added internal citations omitted). "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). As previously discussed, the performance characteristics disclosed in Hijiya do not comprise stability ratios as defined in the present application (See paragraph [0023]). Accordingly, because the Examiner has not shown, with objective evidence, that the missing descriptive matter is necessarily present in the thing described in the reference, claim 1 along with dependent claims 3-4, 8 and 22 are not anticipated.

The rejection should be withdrawn.

Remarks Regarding 35 USC § 103(a)

Claims 6, 7 and 9 stand rejected, under 35 USC §103(a), as allegedly obvious in view of Hijiya and Remmers (US4141603). Applicant respectfully traverses this rejection. More specifically, the Examiner indicated that Hijiya teach the invention with the exception of the

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third configuration comprising four sub-journal bearings.

As noted with regard to the rejections under 35 USC § 102(b), Hijiya do not implicitly or explicitly disclose, teach or suggest each and every element of amended claim 1, from which claims 6, 7 and 9 depend. As previously indicated, Hijiya does not disclose, teach or suggest a method including the steps of 1.) determining a first *stability ratio* for a first journal bearing configuration having at least two sub-journal bearings, 2.) the step of determining a second *stability ratio* for a second journal bearing configuration having at least three sub-journal bearings, wherein each of the at least three sub-journal bearings provide radial stiffness, and 3.) implementing the second journal bearing configuration where the second stability ratio is improved relative to the first stability ratio.

Similarly, contrary to the Examiner's assertion, it is not clear that Hijiya or Remmers disclose, teach or suggest the Applicant's ratios. Indeed, the Examiner's assertion that, "[a]s best understood, Hijiya et al. and Remmers et al. teach the respective length ratios..." it is not sufficient for supporting an obviousness determination. Accordingly, because the combination of the references fails to disclose each and every element of amended claim 1, claim 1 and those claims depending therefrom are nonobvious.

The rejection should be withdrawn.

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Conclusion

Applicants respectfully submit that the present application is in condition for allowance, which action is courteously requested. The fee in the amount of \$120 for a one month extension of time is submitted herewith. Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees to Deposit Account No. 14-1437 referencing Attorney Docket No. 8209.085.US. Please credit any excess fees to such deposit account.

Respectfully submitted,

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